

any additional fees are necessary for this response, the Commissioner is hereby authorized to charge any deficiencies to Deposit Account No. 50-0439.

### REMARKS

Claims 1-52 are pending in this application.

#### *Claim Rejections - 35 USC § 103*

Claims 1-52 were rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III, et al., U.S. Patent No. 5,724,492, in view of Yeh et al., U.S. Patent No. 6,329,978.

The examiner is kindly reminded that in order to establish *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). MPEP § 2141.02

Applicant's invention provides a more informative and useful method of identifying selectable options in a user interface.

All claims recite “at least *two selectable targets* displayed on at least a portion of the display” and “said at least *two selectable targets* capable of being displayed in a simulated rotation about an axis while *remaining continuously selectable during said simulated rotation*”.

Matthews does not teach “at least two selectable targets” nor “said at least two selectable targets . . . remaining continuously selectable during said simulated rotation”. Instead, Matthews only teaches one target (e.g., col. 16, lines 28, 31, 37, 44, 45, 47, 59), only shows a single target (e.g., FIG. 4, 5, 7, 10), and teaches a single three dimensional object which tumbles and rotates about an axis (col. 15, lines 15-35).

The animation of Matthews (e.g. FIGS. 6, 11, and 12) depicts the transitions of a single target (e.g., col. 15, lines 15-18; col. 18, lines 19-24; col. 18, lines 37-40).

Matthews does not teach that the menu panels or choices are continuously selectable because Matthews teaches that they must rotate into view to be selectable (e.g., col. 16, lines 35-36; col. 17, lines 4-8; step 820 of FIG. 8). So, the menu panels and choices are invisible and not selectable for a portion of the time.

Thus, Matthews does not teach or suggest “at least two selectable targets displayed on at least a portion of the display” nor “said at least two selectable targets capable of being displayed in a simulated rotation about an axis while remaining continuously selectable during said simulated rotation”.

Yeh was cited by the Patent Office to provide a teaching for limitations allegedly absent in the primary reference Matthews. The Patent Office asserted “The difference between the claim and Matthews, III et al. is a display, a cursor capable of being displayed on said display; a cursor control device capable of controlling said cursor’s position and movement on said display” (page 1 of Office Action). However, Matthews discloses the allegedly absent features because Matthews discloses a cursor control device and a cursor (col. 12, lines 20-22).

Furthermore, Yeh does not remedy the deficiencies of Matthews because no rotation is disclosed in or suggested by Yeh and no multiple targets are disclosed in or suggested by Yeh. Instead, Yeh is directed to the mechanical function of a cursor control device that uses “rotary circles of the optic grid pieces of the mouse” (col. 2, lines 45-46; col. 1, lines 39-40; col. 1, lines 52-53) and is concerned with measuring distance to extend mouse life (col. 3, lines 1-16).

The combination of Matthews and Yeh is inappropriate because the secondary reference Yeh is cited only to supply a teaching already contained within the primary reference Matthews.

Furthermore, neither Matthews nor Yeh teach or suggest “at least *two selectable targets* displayed on at least a portion of the display” and “said at least *two selectable targets* capable of being displayed in a simulated rotation about an axis while *remaining continuously selectable during said simulated rotation*”.

Thus, it is respectfully submitted that independent claims 1, 14, 27, and 40 are allowable over the prior art of record.

Claims 2, 3, 15, 16, 28, 29, 41, and 42 are allowable because they depend from allowable claims 1, 14, 27, and 40.

Claims 4, 17, 30, and 43 recite “said interface is capable of *displaying additional information*, on at least a portion of said display, associated with a specific target *when said cursor is positioned at least partially within said specific target’s hotspot boundary*”.

Matthews (col. 13, lines 3-23; col. 14, lines 17-25) does not teach the display of “additional information” when the “cursor is positioned at least partially within said

specific target's hotspot boundary". Instead, Matthews displays text (figs. 7 and 10) regardless of whether the cursor is within any boundary area.

Thus, claims 4, 17, 30, and 43 are allowable over the prior art of record for this additional reason.

Claims 5, 18, 31, and 44 recite "said interface is capable of *modifying said targets* being displayed on said display *in response to a change in focus on content being displayed in another portion of said display*".

Matthews discloses pull down menus (col. 1, lines 35-67) and discloses animated dynamic transitions of an object (col. 15, lines 59-67; col. 16, lines 19-24). However, there is no teaching or suggestion in Matthews for the limitation "said interface is capable of modifying said targets being displayed on said display in response to a change in focus on content being displayed in another portion of said display".

Therefore, claims 5, 18, 31, and 44 are allowable for this additional reason.

Claims 6, 7, 19, 20, 32, 33, 45, and 46 are allowable because they depend from allowable base claims 1, 14, 27, and 40.

Claims 8, 20, 33, and 46 recite "said cursor is capable of *modifying* its presentation into *a shape similar to the shape of a specific target* which is being given focus by said cursor". Claims 9, 21, 34, and 47 further recite that the cursor takes on "a shape similar to a miniature version of the shape of said specific target".

Matthews discloses icons and pull down menus (col. 1, lines 20-67), a set-top terminal that requests the downloading of program modules (col. 11, line 50, through col. 12, line 10), and keys on a remote control unit (col. 12, lines 19-24), but does not disclose or suggest a cursor which is "capable of modifying its presentation into a shape similar to

the shape of a specific target which is being given focus by said cursor" or a miniature version.

Thus, it is respectfully submitted that claims 8, 9, 21, 22, 34, 35, 47, and 48 are allowable over the prior art of record for this additional reason.

Claims 10-13, 23-26, 36-39, and 49-52 are allowable over the prior art of record because they depend from allowable claims 1, 14, 27, and 40.

In summary, there is no suggestion or motivation in the prior art of record to modify Matthews or to combine Matthews with Yeh. Neither Matthews nor Yeh teach or suggest all the claim limitations of the independent claims. Additionally, Matthews and Yeh do not teach or suggest limitations found in certain dependent claims as discussed above. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. Thus, according to MPEP § 2142, a *prima facie* case of obviousness has not been established.

### CONCLUSION

In light of the foregoing arguments, reconsideration of all pending claims is requested, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,  
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